

## **RESPONSE**

As a preliminary matter, Applicant notes that an Electronic Information Disclosure Statement was filed in the instant case on December 17, 2002; however, the Examiner has not returned an initialed copy of the Electronic IDS. Applicant respectfully requests that the Examiner return an initialed copy of the Electronic IDS filed December 17, 2002 in order to acknowledge that the cited art has been considered.

### **The 35 U.S.C. § 112, First Paragraph Rejection**

The Examiner has rejected claims 33-43 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. In particular, the Examiner states that the specification fails to describe a representative number of diseases expressing tenascin-C to convey to one skilled in the art that as of the filing date the applicant was in possession of the claimed invention. While not acquiescing in the rejection, for the purposes of expediting allowance of the application the Applicant has amended the claims to recite that the disease is selected from the group consisting of cancer, psoriasis, and atherosclerosis. Withdrawal of the rejection is respectfully requested.

### **The 35 U.S.C. § 112, Second Paragraph Rejections**

The Examiner has rejected claims 33-43 under 35 U.S.C. § 112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular

the Examiner objected to the phrase "disease that is expressing" in claims 33-43. The Examiner also objected to "said tumor" in claims 33-42 as lacking antecedent basis. By way of the foregoing amendments to the claims, it is believed that the § 112, Second Paragraph rejections have been overcome. Withdrawal of the rejection is respectfully requested.

#### **The Statutory Double Patenting Rejections**

Claims 1-14 stand rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-14 of prior U.S. Pat. No. 6,232,071. In response to this rejection, claims 1-14 have been cancelled.

Claims 15-32 stand rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-18 of prior U.S. Pat. No. 6,569,491. In response to this rejection, claims 15-32 have been cancelled.

#### **The Double Patenting Obviousness Type Rejection**

Claims 33-42 (drawn to a method of detecting a disease by detecting tenascin-C expression in a biological tissue) stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Pat. No. 6,596,491 and claims 1-10 of U.S. Pat. No. 6,232,071. Applicant respectfully submits that this rejection is in error. Note that new claims 44-58 correspond to rejected claims 34-42; therefore, the rejection is discussed with reference to amended claim 33 and new claims 44-58.

37 CFR § 1.130(b) states:

When an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting

rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

U.S. Pat. No. 6,596,491 is a divisional application of United States Patent Application Serial No. 09/364,902, now U.S. Pat. No. 6,232,071. The instant application claims priority to USSN 09/364,902. When USSN 09/364,902 was filed, a restriction requirement was made under 35 U.S.C. § 121. In that restriction requirement, the following four inventions were identified:

- I. Nucleic acid ligands and method of making, classified in class 536, subclass 24.3;
- II. Tenascin-C nucleic acid ligand complexes and methods of making, classified in class 424, subclass 9.43;
- III. Method to detect tenascin-C, classified in class 435, subclass 6;  
and
- IV. A method to treat disease, classified in class 514, subclass 44.

Between Groups I, II, III, the Examiner of USSN 09/364,902 noted that the claims were patentably distinct because the method of detection of Group III can be practiced with other materially different products than those of Group I and II. Group I was elected without traverse in USSN 09/364,902. Group II was then elected in USSN 09/854,662 (now U.S. Pat. No. 6,596,491). A copy of the restriction requirement from USSN 09/364,902, and the claims filed in that application, are enclosed for the Examiner's convenience.

Pending claims 33 and 44-58 of the instant application, like the claims of Group III of priority application USSN 09/364,902, are directed to a method for detecting the presence of a disease in a biological tissue by detecting tenascin-C expression in that tissue. The issuance in USSN 09/364,902 of a requirement for restriction between such detection method claims and claims directed to nucleic acid ligands (Group I) and nucleic acid ligand complexes (Group II) therefore indicates that the instant method of detection claims are patentably distinct from claims 1-10 of U.S. Pat. 6,232,071 and claims 1-18 of U.S. Pat. No. 6,596,491.

Applicant respectfully submits that it is not appropriate, therefore, to require the filing of a terminal disclaimer in the instant case over claims 1-10 of U.S. Pat. No. 6,232,071 and claims 1-18 of U.S. Pat. No. 6,596,491. Withdrawal of the obviousness-type double patenting rejections is respectfully requested.

### Conclusion

For the reasons set forth above, Applicant respectfully submits that the pending claims as are allowable and reconsideration and issuance of a notice of allowance are respectfully requested. If it would be helpful to obtain favorable consideration of this case, the Examiner is encouraged to call and discuss this case with the undersigned.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117 if not otherwise specifically requested. The undersigned hereby authorizes the charge of any required fees not included or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Very truly yours,

Date: 11/12/2003



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